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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,476

Applicant(s)

TANAKA, KEISUKE

Examiner

Mark R. Milia

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/8/06 and has been entered and made of record. Currently, claims 1, 2, 4-9, 11-16, and 18-22 are pending.

Oath/Declaration

2. The examiner acknowledges the receipt of the Declaration as was requested in the previous Office Action.

Drawings

3. Applicant's amendment to the specification to insert previously omitted reference numerals has overcome the objection as cited in the previous Office Action. Therefore the objection has been withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The term "low" in claim 22 is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 2, 4-9, 11-16, and 18-21 have been considered but are moot in view of the current amendments to the claims and therefore new ground(s) of rejection will be made. Newly added claim 22 will be addressed in the following rejection. The examiner agrees that Chui does not disclose setting the storage period of image data. However, Chui does disclose using the image data to create greeting cards, postcards, etc. The reference of Enomoto discloses storage time designation data that can be added to the print order data that a user sends to the print-processing center. Therefore a user can designate a particular storage period based on the type of image data the user desires to print. The combination of Chui and Enomoto yields the newly added limitations set forth in claims 1, 8, and 15.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 2, 4, 8, 9, 11, 15, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui in view of Enomoto.

Regarding claim 1, Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52), displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47), and wherein the order for the print of the image data is an order for a postcard (see column 4 lines 13-22 and column 23 lines 9-23).

Chui does not disclose expressly the step of setting a storage period of the image data to a period corresponding to a content of the postcard.

Enomoto discloses the step of setting a storage period of the image data to a period corresponding to a content of the postcard (see column 8 lines 19-33, reference discloses a storage time designation data that can be added to the print order data that a user sends to the print-processing center, thereby allowing a user to designate a particular storage period based on the type of image data the user desires to print).

Regarding claim 8, Chui discloses a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), wherein the server stores the image data transferred thereto regardless of whether or not the order is placed at the time of transfer of the image data, and receives the order for the print regarding the image data stored therein after the image data are stored therein in the case where the order was not placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47), displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47), and wherein the order for the print of the image data is an order for a postcard (see column 4 lines 13-22 and column 23 lines 9-23).

Chui does not disclose expressly the step of setting a storage period of the image data to a period corresponding to a content of the postcard.

Enomoto discloses the step of setting a storage period of the image data to a period corresponding to a content of the postcard (see column 8 lines 19-33, reference discloses a storage time designation data that can be added to the print order data that a user sends to the print-processing center, thereby allowing a user to designate a particular storage period based on the type of image data the user desires to print).

Regarding claim 15, Chui discloses a computer-readable recording medium storing a program to cause a computer to execute a print ordering method used in a print ordering system, the print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the program comprising the procedures of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65 and column 12 lines 39-51) and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52), displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line

66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47), and wherein the order for the print of the image data is an order for a postcard (see column 4 lines 13-22 and column 23 lines 9-23).

Chui does not disclose expressly the step of setting a storage period of the image data to a period corresponding to a content of the postcard.

Enomoto discloses the step of setting a storage period of the image data to a period corresponding to a content of the postcard (see column 8 lines 19-33, reference discloses a storage time designation data that can be added to the print order data that a user sends to the print-processing center, thereby allowing a user to designate a particular storage period based on the type of image data the user desires to print).

Chui & Enomoto are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the setting of a storage period, as described by Enomoto, with the system of Chui.

The suggestion/motivation for doing so would have been to provide a user with greater control over the transmitted images, especially the period of time in which the image will be available to the user.

Therefore, it would have been obvious to combine Enomoto with Chui to obtain the invention as specified in claims 1, 8, and 15.

Regarding claims 2, 9, and 16, Chui further discloses accepting and storing image data (see column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-column 14 line 8 and column 14 lines 47-52) and Enomoto further discloses accepting and storing the image data at the time the order is received if the order is placed at the time the image data are transferred (see abstract, column 3 lines 45-48 and 61-63, column 4 lines 61-65, column 6 lines 23-54, and column 7 lines 15-22, reference shows that the order data and image data are transmitted at the same time to the photo-finisher for output and delivery of prints).

Regarding claims 4, 11, and 18, Enomoto further discloses deleting the image data from the server after a predetermined storage period has elapsed since the image data were put into storage (see column 8 lines 19-26, reference discloses setting a storage time period, after which the image is no longer available, or deleted).

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chui in view of Enomoto and U.S. Patent No. 6980668 to Naito et al.

Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image

data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52).

Chui does not disclose expressly performing transfer of the image data to the server when communications costs are low and writing a storage period of the image data in tag information of the image data.

Enomoto discloses writing a storage period of the image data in tag information of the image data (see column 8 lines 19-33).

Naito discloses performing transfer of the image data to the server when communications costs are low (see column 39 line 60-column 40 line 3).

Chui, Enomoto, & Naito are combinable because they are from the same field of endeavor, ordering of prints over a network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the writing a storage period of the image data in tag information, as described by Enomoto, and the transferring of image data to a server when communications costs are low, as described by Naito, with the system of Chui.

The suggestion/motivation for doing so would have been to save money and be able to provide lost cost prints to a user by utilizing low cost communications and purging of image files after a certain period of time.

Therefore, it would have been obvious to combine Enomoto and Naito with Chui to obtain the invention as specified in claim 22.

11. Claims 5-7, 12-14, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui and Enomoto as applied to claims 1, 8, and 15 above, and further in view of Fredlund et al.

Regarding claims 5, 12, and 19, Chui and Enomoto do not disclose expressly extending the storage period for the image data regarding which the order was placed.

Fredlund discloses extending the storage period for the image data regarding which the order was placed (see column 3 lines 47-54).

Regarding claims 6, 7, 13, 14, 20, and 21, Chui and Enomoto do not disclose expressly displaying the storage period on the user terminal.

Fredlund discloses displaying the storage period for the image data (see column 3 lines 41-57).

Chui, Enomoto & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the deletion of image data after a predetermined period of time and extension of storage period and the ability to display both as described by Fredlund and displaying the information regarding storage period on a user terminal, which is well known in the art, with the system of Chui and Enomoto.

The suggestion/motivation for doing so would have been to provide a user with greater control over the transmitted images and decrease the amount of memory

needed to store image data by purging the image data that is not used after a predetermine amount of time.

Therefore, it would have been obvious to combine Fredlund with Chui and Enomoto to obtain the invention as specified in claims 5-7, 12-14, and 19-21.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to the attached Notice of References Cited.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia
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